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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)									
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		09/893,547	June 29, 2001								
		First Named Inventor									
		Jonathan Sharp									
		Art Unit	Examiner								
		2152	Victor D. Lesniewski								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td>_____/Allen E. Hoover/_____ Signature</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td>_____ Allen E. Hoover Typed or printed name</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. 37,354 Registration number _____</td><td>_____ 312-463-5000 Telephone number</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td>_____ January 3, 2007 Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>				<input type="checkbox"/> applicant/inventor.	_____/Allen E. Hoover/_____ Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	_____ Allen E. Hoover Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. 37,354 Registration number _____	_____ 312-463-5000 Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	_____ January 3, 2007 Date
<input type="checkbox"/> applicant/inventor.	_____/Allen E. Hoover/_____ Signature										
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<input checked="" type="checkbox"/> attorney or agent of record. 37,354 Registration number _____	_____ 312-463-5000 Telephone number										
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	_____ January 3, 2007 Date										

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Sharp et al.)	Atty. Docket 004770.00976
)	No.
Serial 09/893,547)	
No.)	Group Art Unit: 2152
Filed: June 29, 2001)	
)	Examiner: Lesniewski,
For: APPARATUS AND METHODS FOR CLIENT)	Victor D.
SERVER SYSTEM)	Confirmation 4444
		No.

PRE-APPEAL REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This document constitutes Appellant's pre-appeal request for review.

In this application, all of the claims stand rejected under 35 U.S.C. §102 or 103 over a patent to Peng (U.S. Patent 6,816,944). There are two significant flaws with these rejections. First, the Examiner has failed to establish that the Peng reference may be asserted as prior art against the present application. Second, even assuming the Peng reference were prior art, the Peng reference fails to disclose or suggest the features of the claims of the present application. Given these deficiencies in the Peng reference, withdrawal of the rejections is required.

By way of background, the invention is directed towards methods, systems, and devices that are useful in connection with downloading of electronic content to a portable radio communication device. The patent is referred to the specification for further details. One aspect of the claimed invention is that remuneration data relating to the electronic content is computed. Claim 15 may be deemed representative of the pending claims:

A method for downloading adaptation data from a server to a portable radio communication device, said method comprising:

providing electronic content for storage on a memory of said portable radio communication device;

providing said adaptation data on a memory of said server;

allowing access to said adaptation data on said server for downloading from said memory of said server to said portable radio communication device;

downloading said adaptation data from said memory of said server to said portable radio communication device;

monitoring downloading of said adaptation data by said portable radio communication device from said memory of said server to provide output data;

applying said adaptation data to said electronic content so as to modify said electronic content to provide adapted electronic content;

generating data based on the output data of said monitoring downloading of said adaptation data; and

computing remuneration data related to the electronic content and the adaptation data based on the generated data.

(Emphasis added). All of the claims of the present application specify “computing” or an analogous concept (*see* Claim 18, “computing means”; Claim 22, “computing means”; Claim 23, “computing”; and Claim 26. “an account registered configured to compute”).

Peng’s patent does not disclose or suggest the concept of “computing.” Peng states merely that “tracking also facilitates billing by providing a detailed record of each user’s billable activity.” At most, Peng teaches a system that monitors a user’s activities. Peng does not provide a system that computes remuneration data based on the disclosed user activities. The Examiner has pointed to Peng at Column 7, lines 44-46, as allegedly providing support for this feature. At the cited passage, Peng simply discloses a transaction tracking feature. The general concept of transaction tracking is not the same as the “generating” and “computing” steps specified in Claim 15, and the rejection is therefore unsupported. The other pending claims are patentable over Peng for similar reasons.

Given Peng’s failure to teach the “computing” limitation, it should not be surprising that many other features of the claimed invention are likewise absent from Peng. For instance, with reference only to claim 15, where in Peng can “adaptation data” or “generated data” be found? Where is “computing remuneration data . . . based on the generated data”? Claim 15 is several steps removed from Peng. Other reasons for patentability over Peng are presented by the remaining claims. Peng is simply off the mark.

Thus, even if Peng were deemed prior art to the present application, Peng would fail to support a rejection under 35 U.S.C. 102 or 103.

Even if the foregoing defect were overlooked, there is a more fundamental defect in the rejection that provides an independent reason for reversing the Examiner: Peng *is not prior art* to the present application. The present application claims priority to a United Kingdom application filed on June 30, 2000. A copy of the priority application is of record in the present application. The claimed invention is supported by the priority application (*see, e.g.*, page 6 lines 29-32 of the specification of the priority application). The Peng reference has a filing date of February 1, 2001. The date of the Peng patent is later than that of the priority date of the present application. Accordingly, the Peng reference is not, by itself, available for consideration under 35 U.S.C. §102(e).

Peng does claim priority to a provisional application filed in February of 2000. (The Peng provisional application number is 60/179,761; the specification of this application is available via PAIR). The Peng reference is citable against the present application only “if the provisional application properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. §112, first paragraph.” M.P.E.P. 2163.03 (III).

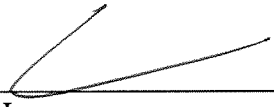
In this respect, the priority application fails. The examiner has failed to find any support in the Peng provisional application for the passage relied on to support the rejection. As will be evident upon a review of the Peng provisional application, this document is little more than a collection of technical literature. The Peng priority application bears little resemblance to the issued Peng patent. This provisional application does make a general reference to a gateway for “user tracking info” (*see, e.g.*, page 57), but this general statement says nothing about computing, and does not support the “transaction tracking module” of the Peng patent (to the extent that that module is said to support the claim rejection). Peng accordingly is unavailable as prior art.

Both of the foregoing arguments were presented to the examiner below. In the advisory action, the Examiner offered only a cursory analysis of Peng, stating that “Peng’s gateway is in fact a computer.” The specific hardware employed by Peng is not at issue. What is relevant is that Peng’s computer is employed for a monitoring function, not for computing remuneration data. Moreover, the Examiner ignored altogether the issue of whether the Peng provisional application supported the rejection. Absent an analysis of the Peng provisional application, the Examiner has not even made a *prima facie* showing that Peng is prior art.

In summary, upon even a cursory analysis of the Peng reference and of the Peng priority application, it is evident immediately that the rejection is unsupportable and must be withdrawn.

Respectfully submitted,

Date: January 3, 2007



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